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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,512	01/22/2001	William Vong	MS1-155USC3	3413

22801 7590 03/27/2003

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EXAMINER

SHIN, CHRISTOPHER B

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/767,512

Applicant(s)

VONG ET AL.

Examiner

C Shin

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-20,23 and 40-47 is/are pending in the application.
- 4a) Of the above claim(s) 40 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-20,23 and 40-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The Amendment received January 3, 2003 has been entered and carefully considered. Claims 15-23 are pending in the application. Claims 40 & 47 are withdrawn from consideration. Claim 40 & 47 raises potential Double Patenting rejection against the Parent Patent(s), if the claims 40 & 47 are considered. The examiner notes that the earlier parent applications had restrictions requirements including the above subject matter.

#### ***Original Presentation***

2. As can be seen from the newly added claims 40 & 47, the limitations of the claims 40-47 present a subject matter that are not originally elected by the applicant. As can be seen from claims 18, 19, 20, 23, 42, the original invention is directed to LED limitations without power limitation; however, claims 40 & 47, in addition to the originally elected invention claims, now additionally elects the invention (e.g., power) that are patentable distinct from the originally elected claims. Claim 47 is respectively separate invention groups from the claims 18-20, 23 & 40-47. Within the group claim 18-20 23 & 40-47, the claim 40 is a distinct specie. All of the two separate inventions group I (claims 18-20, 34, 41-46) & group II (claims 40 & 47) are related as subcombinations usable together.

#### ***Response to Arguments***

3. In response to the applicant's arguments of the amendment, the examiner modified the art rejection as follows.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 18-20, 23 & 40-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidaka (5,606,712).

i. The examiner relies on the examiner cited references as being the well known common knowledge in the art LED alert/display notification technique.

ii. Hidaka teaches the claimed limitations as follows:

Claims 18-20,23,41-46      Hidaka

- portable handheld computing device
  - feature of figure 1
- a casing having upper and lower surfaces, opposing front and back side surfaces an opposing end surfaces, end being dimensionally shorted than the front and back side surfaces
  - feature of figure 1
- light emitting device (LED) mounted externally on the casing
  - feature of (18) of figure 1
- LED being positioned on the upper surface and wrapping around and being raised on one of the end surfaces
  - feature of (18) of figure 1
- LED being activated upon occurrence of an event to notify a user
  - feature of (18) of figure 1

iii. The difference between the claimed invention and the teachings of the Hidaka reference is that the reference does not expressly disclose the exactly same physical shape of LED (i.e., physical situations of the LED) & the off button integration . However, such difference in limitation is a design choice matter to one having ordinary skill in the art. The examiner takes official notice on such design choice matter such as off button integration (e.g., as can be seen from the examiner cited references, Weber (4,056,701) & Wunsch et al. (4,454,596) both teach the well known light emitting deice & button combinations) This is because the physical situation of the LED is chosen by the designer with a motivation of choosing better visible location; one skilled artisan can easily choose a specific location or more than one locations to serve the purpose of alerting a user. In addition, the Hidaka reference teaches, in column 5, lines 55-57, the motivation of using LED in a highly visible manner. More specifically, Hidaka states “LED cover 18 serves to extract light of a reception indicating LED from the front , side and back of the cover

2" . As can be seen from the Hidaka reference teachings, Hidaka clearly discloses the motivation of highly visible location of the LED. Therefore, it would have been obvious at the time the invention was made to one having ordinary skill in the art to come up with the invention from the teachings of the Hidaka reference, for the reasons stated above.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. **Any Response To This Action Should Be Mailed To:**

**If The Action Is Non-Final**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 746-7239, (for formal communications intended for entry)

**If The action is Final**

**Box AF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

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(703) 746-7238, (for formal communications; please mark "EXPEDITED  
PROCEDURE")

**Hand-delivered responses should be brought to**

Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

**Any Other Telephone Communication Should Be Directed To**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Shin whose telephone number is (703) 305-9658. The examiner can normally be reached on Monday - Thursday from 7:00 AM to 4:00 PM.

Christopher B. Shin  
March 24, 2003

*Christopher B. Shin*

**PRIMARY EXAMINER**

**ART UNIT 2182**

